

REMARKS

Claim Rejections under 35 USC § 102

Claims 1, 2, 6, 7, 10, 11, 13-24, 26-34, 42, 43, 45-47 and 49 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,503,613 to Weinberger. Applicant respectfully traverses this rejection.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. Of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic Research & Foundation v. Genentech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Claim 1, as amended, recites in part, “at least one fluid communication structure integrally formed on the catheter body, wherein the at least one fluid communication structure comprises at least one bulk formed on the catheter body and at least one conduit formed on the bulk, wherein the at least one conduit is adapted to permit fluid flow through a biological path.” Weinberger’s bulk 5a does not have “at least one conduit formed on the bulk, wherein the at least one conduit is adapted to permit fluid flow through a biological path.” Weinberger discloses “. . . inflation of the balloon section 5a at the distal end of the balloon catheter 5 in the conventional manner.” (col. 6, lines 47-48). Thus, Weinberger’s balloon section 5a, when inflated, abuts against the wall of the biological path and does not permit fluid flow through the biological path. Because the balloon 5a is the only structure “formed on the catheter body” and it does not have the properties recited in claim 1, Applicant respectfully requests that this rejection of claim 1 and its dependent claims 6, 7, and 10 be withdrawn.

In regards to claim 11, Weinberger lacks disclosure or suggestion of a “perfusion hole”, and the Applicant respectfully requests that the rejection of claim 11 be withdrawn.

In regards to claims 13 and 14, Wienberger lacks disclosure or suggestion of an “exterior conduit.” Accordingly, Applicant respectfully submits that Wienberger does not anticipate claims 13 and 14., and requests that the rejection of claims 13-24 and 26-34 be withdrawn.

Because claim 1 is allowable over Wienberger, claims 42, 43, 45-47 and 49, which further limit claim 1, are clearly allowable over Wienberger.

Claims 1, 2, and 4 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,883,459 to Calderon. Applicant respectfully traverses this rejection.

Claim 1, as amended, recites in part, “at least one fluid communication structure integrally formed on the catheter body, the at least one fluid communication structure comprises at least one bulk formed on the catheter body and at least one conduit formed on the bulk, wherein the at least one conduit is adapted to permit fluid flow through structure comprises at least one bulk formed on the catheter body and at least one conduit formed on the bulk, wherein the at least one conduit is adapted to permit fluid flow through a biological path.” Calderon’s bulks 22 and 56, just like Wienberger’s bulk 5a, do not have “at least one conduit formed on the bulk, wherein the at least one conduit is adapted to permit fluid flow through a biological path.” Claims 1 and 4 are, therefore, not anticipated by Calderon.

Claims 1, 2, 7-9, 11-14, and 35-41 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,423,725 to Baran et al. Applicant respectfully traverses this rejection.

Baran describes a bulk (balloon E) and a fluid conduit P extending through the bulk. However, since conduit P only opens into the internal cuff E, it will not permit fluid to flow through a biological path. Claims 1 is, therefore, not anticipated by Baran. Accordingly, Applicant respectfully requests that the rejection of claim 1 and its dependent claims 7-9 be withdrawn.

In regards to claim 11, Baran lacks disclosure or suggestion of a “guidewire channel” in the catheter body, a “guidewire disposed within the guidewire channel...,” and a “guidewire exit port....” As such, Applicant respectfully submits that Baran does not anticipate the instant invention as described in claim 11.

In regards to claims 13 and 14, Baran lacks disclosure or suggestion of a “more interior conduit used for placing devices used in catheter operations”, and Applicant respectfully requests that the rejection of independent claims 13 and 14, as well as dependent claims 35-41 be withdrawn.

Claim Rejections under 35 USC § 103

Claim 5 stands rejected under 35 USC § 103(a) as being unpatentable over Calderon. Applicant respectfully traverses this rejection.

To establish a prima facie case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claim 5 depends on claim 4 which depends on claim 1. As described earlier, Calderon's bulks 22 and 56 do not have "at least one conduit formed on the bulk, wherein the at least one conduit is adapted to permit fluid flow through a biological path," as recited in claim 1. Nor does Calderon teach or suggest such conduits. As such, Applicant respectfully submits that claim 1 is not obvious over Calderon and, accordingly, is patentable over Calderon.

In view of the foregoing remarks, favorable reconsideration of all pending claims is requested. Applicant respectfully submits that this application is in condition for allowance and requests that a notice of allowance be issued. Should the Examiner believe that anything further is required to expedite the prosecution of this application or further clarify any remaining issues, the Examiner is requested to contact Applicant's attorney at the telephone number listed below.

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Respectfully submitted,



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